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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/650,537	08/28/2003	Gregory G. Kuelbs	0638MH-40982-US	9033
38441	7590	09/21/2005	EXAMINER	
LAW OFFICES OF JAMES E. WALTON, PLLC 1169 N. BURLESON BLVD. SUITE 107-328 BURLESON, TX 76028			SAWHNEY, HARGOBIND S	
			ART UNIT	PAPER NUMBER
			2875	

DATE MAILED: 09/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

AK

**Office Action Summary**

Application No.

10/650,537

Applicant(s)

KUELBS, GREGORY G.

Examiner

Hargobind S. Sawhney

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 21-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>8/26/05</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION*****Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claim 21-34 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 78-92 of copending Application No. 10/829,790. The conflicting claims are identical, they are not patentably distinct from each other as detailed below.

Instant Application No.	Copending Application	Discussion on differences, and additional References:
10,650,537	No. 10,829,790	
Claims 21-34	Claim 78-92	Claims 21-34 of the instant application are identical to the respective claims 78-92 of the copending application 10,829,790.

It would be have been obvious to one of ordinary skill in the art at the time of the invention to meet the limitations of claims 21-34 of the instant application with the claimed features of claims 78-92 of the copending application 10,829,790

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 21 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Perrier et al. (WO Patent No.; 93/00840), hereinafter referred as Perrier.

The following examination has used the English translation of the Perrier, which was included in the Information Disclosure Statement (IDS) filed on August 26, 2005.

Regarding claims 21 and 23, Perrier discloses an umbrella apparatus 1 (Figure 1) comprising:

- a canopy portion 8 hingedly coupled to a pole portion 9 (Figure 1, English translation, page 2, line 1); a rechargeable electrical power system 3 – rechargeable batteries - energizing the umbrella apparatus 1 (Figure 1, English translation, page 2, lines 10 and 11); a solar system 2 disposed on

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- the top of the pole portion 9 above the canopy 8 (Figure 1, English translation, page 2, lines 9 and 10); the solar system 2 able to collect solar energy, and convert solar energy into electrical energy (Figure 1, English translation, page 2, lines 9-11); the solar system conductively coupled, with electrical wires 22 (Figure 2), to the rechargeable electrical power system 3 (Figure 1, English translation, page 2, lines 9 and 10); the electrical energy converted from the solar energy by the solar system 2 being used for recharging the rechargeable electrical energy system 3 (Figure 1, English translation, page 2, lines 10 and 11); and
- the rechargeable energy system 3 disposed by the second housing 4 below the canopy portion 8 (Figure 1, English translation,, page 2, lines 10 and 11).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Perrier et al. (WO Patent No.; 93/00840), hereinafter referred as Perrier, in view of Cathel (US Patent No.; 6,299,325).

The following examination has used the English translation of the Perrier, which was included in the Information Disclosure Statement (IDS) filed on August 26, 2005.

7. Regarding claim 22, Perrier discloses an umbrella apparatus 1 (Figure 1) comprising a solar energy system disposed in a housing on the top of the pole portion above the canopy, and a rechargeable energy system – a rechargeable battery – positioned in a separate housing positioned below the canopy portion. However, Perrier does not teach a single housing accommodating both the rechargeable energy system and solar energy system above the canopy, and the housing mounted on the pole portion above the canopy portion.

On the other hand, Cathel ('325) discloses an illuminated sign (Figure 1) including a housing 26 accommodating a solar panel 60 and a rechargeable electrical power source 64 (Figures 1 and 2, column 3, lines 13 and 46-51).

It would be have been obvious to one of ordinary skill in the art at the time of the invention to modify the umbrella apparatus of Perrier by positioning the solar panel and the rechargeable batteries in a housing as taught by Cathel for the benefits of cost saving resulting from reduction of parts of the device.

8. Claims 24 -27, 29, 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perrier et al. (WO Patent No.; 93/00840), hereinafter referred as Perrier, In view of Valdner (US Patent No.: 5,349,975).

Regarding claim 24, Perrier discloses a solar energy based umbrella apparatus comprising an electrical charging system receiving power from a solar energy system.

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However, Perrier does not disclose an umbrella apparatus comprising a charging system receiving power from AC power outlet.

On the other hand, Valdner ('975) discloses a an umbrella apparatus 10 including a recharging system 56 receiving power from AC power outlet 54 for recharging the rechargeable energy system 44 (Figures 1 and 3, column 2, lines 37-43).

It would be have been obvious to one of ordinary skill in the art at the time of the invention to modify the umbrella apparatus of Perrier by providing the AC-based charging system in addition to the solar energy based charging system as taught by Valdner ('975) for the benefits of highly reliable and economical power-supply system based on redundancy of the power sources.

Regarding claim 25, Perrier discloses a solar energy based umbrella apparatus comprising removable a base portion attached to a pole portion. However, Perrier does not specifically disclose the base being a removable from the pole portion.

On the other hand, Perrier teaches the umbrella apparatus including a pole portion 9 received in a sleeve – an extension of the base portion 4 – ; and the base portion 4 being removable by removing the adjusting screw (Figure 10).

It would be have been obvious to one of ordinary skill in the art at the time of the invention to apply the teaching of Perrier, as interpreted above and illustrated in Figure 1, an modify the umbrella apparatus for the benefits of easy assembly and economical storage and shipping.

Regarding Claim 26, Perrier discloses the umbrella apparatus 1 (Figure 1) including the rechargeable electrical power system 3 positioned in the base 3 (Figure 1, English translation,, page 2, lines 10 and 11).

Regarding Claim 27, dependent on Claim 25, Perrier in view of Valdner ('975) discloses an umbrella apparatus meeting the limitations in similar manner as applied for Claim 24 detailed above.

Regarding Claim 29, dependent on Claim 25, Perrier discloses a solar energy based umbrella apparatus comprising an electrical recharging system receiving power from a solar energy system. However, Perrier does not disclose an umbrella apparatus comprising a rechargeable electrical power system, which is detachable from the umbrella apparatus, and attachable to a remote an AC docking station.

On the other hand, Valdner ('975) discloses a an umbrella apparatus 10 including a rechargeable electrical power system 44, which is detachable from the umbrella apparatus 10, and attachable to a remote an AC docking station receiving power plug 58 (Figure 3, column 2, lines 37-43).

It would be have been obvious to one of ordinary skill in the art at the time of the invention to modify the umbrella apparatus of Perrier by providing the AC-based rechargeable power system as taught by Valdner ('975) for the benefits of highly reliable and safe power-supply system promoting relocation of the device.

Regarding Claim 30, dependent on Claim 21, Perrier discloses a solar energy based umbrella apparatus comprising a solar energy system conductively coupled to a rechargeable electrical power system. However, Perrier does not specifically teach the



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the solar power energy system conductively coupled to the rechargeable electrical power system by a releasable plug, the engagement of which would allow recharging of the rechargeable electrical power system.

On the other hand, Valdner ('975) discloses a an umbrella apparatus 10 including a rechargeable electrical power system 44, which is detachable from the solar energy system by a plug 46 (Figure 3, column 2, lines 34-37)

It would be have been obvious to one of ordinary skill in the art at the time of the invention to modify the umbrella apparatus of Perrier by providing the releasable plug as taught by Valdner ('975) for the benefits of recharging the electrical power system in a controlled manner.

9. Claims 31, 32 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perrier et al. (WO Patent No.; 93/00840), hereinafter referred as Perrier, In view of Lee (US Patent No.: 6,499,856 B2).

Regarding Claim 31, dependent on Claim 21, Perrier discloses a solar energy based umbrella apparatus comprising a plurality of rib members supporting a canopy, and alighting system conductively coupled to the rechargeable electrical power system. However, Perrier dose not teach the lighting system carried by the ribs members.

On the other hand, Lee ('856 B2) discloses an umbrella apparatus (Figure 1) comprising a plurality of rib members 4 supporting a lighting system 5 (Figure 1, column 2, lines 9 and 10).

It would be have been obvious to one of ordinary skill in the art at the time of the invention to modify the umbrella apparatus of Perrier by providing and positioning the

lighting system as taught by Lee ('856 B2) for the benefits of high attention and decorative values of the device.

Regarding claim 32 and 34, Perrier in view of Lee ('856 B2) discloses the umbrella apparatus further including the light system including:

- a plurality of lighting elements 5 recessed within the rib members 5 (Lee, Figure 1, column 2, lines 9 and 10); and
- a collapsible cover 2 (Perrier, Figure 1); a hub member 20 (Perrier, Figure 1, English translation, page 2, line 18); a strut 15 hingedly connected between the hub 20 and each of the rib members of the canopy 8 (Perrier, Figure 1, English translation, page 2, line 3); and
- a lighting system 5 carried by the strut 2 (Lee, Figure 1, column 2, lines 9 and 10).

10. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Perrier et al. (WO Patent No.; 93/00840), hereinafter referred as Perrier, In view of Mai (US Patent No.: 6,270,230 B1).

Regarding Claim 33, dependent on Claim 21, Perrier discloses a solar energy based umbrella apparatus comprising: a collapsible cover 2 supported a plurality of rib members, supporting a canopy 8 (Perrier, Figure 1). However, Perrier dose not teach the lighting system being carried by the collapsible cover.

On the other hand, Mai (230 B1) discloses an Umbrella apparatus including a lighting system 83 carried by the collapsible cover 30 (Figure 1, column 2, lines 64- and 65).

It would be have been obvious to one of ordinary skill in the art at the time of the invention to modify the umbrella apparatus of Perrier by providing and positioning the lighting system as taught by Mai ('230 B1) for the benefits of high attention and decorative values of the device.

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Lee (US Patent No.: 6,666,224 B2), Pan et al. (US Patent No.: 6,439,249 B1), Yang (US Patent No.: 6,341,873 B1), Wu (US Patent No.: 6,126,293), Wu (US Patent No.: 6,089,727) and Rushing (US Patent No.: 5,307,931)


12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hargobind S Sawhney whose telephone number is 571 272 2380. The examiner can normally be reached on 6:15 - 2:45.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on 571 272 2378. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HSS  
9/16/2005

  
Stephen Husar  
Primary Examiner